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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,331	06/15/2000	Robert J. Mattila	1894-174	8526

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EXAMINER

BEX, PATRICIA K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 02/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/594,331

Applicant(s)

MATTILA ET AL.

Examiner

P. Kathryn Bex

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 7,8 and 16-21 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 is/are allowed.
- 6) ☒ Claim(s) 9-10, 14-15 is/are rejected.
- 7) ☒ Claim(s) 11-13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

1. Any rejection/objection not repeated herein has been withdrawn by the Examiner.

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of Figures 10 and 11, filed on December 16, 2002 have been approved.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must *clearly* show every feature of the invention specified in the claims. Therefore, pipette compartment with *spring-loaded v-shaped members* claims 1 and 9 must be shown or the feature(s) canceled from the claim(s). Although reference number 11 does correspond to the spring-loaded v-blocks, the drawings do not clearly show the invention as specified in the claims. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 9-10, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen *et al* (USP 6,293,750 B1) in view of Anami (USP 5,582,298) or Applicants' admission of prior art.

Cohen *et al* teach a robotic system for transporting containers and objects within an automated analytical instrument. The analytical instrument 10 has a sample handler module 20 for feeding and storing test tubes of various sizes or reagent containers to the instrument 10. Sample handler 20 may include a reagent activator 36 for preparing reagent packages for use by analytical modules. There may also be a module 31 for processing the tubes before analysis, including a predilution apparatus for adding reagents and diluents to and incubating samples. There may also be one or more analytical modules including a clinical analysis module 33, and an immunoassay module represented by box 34. Cohen *et al* teach the robotic transport of reagent containers having an elongated body with at least one well, with a wide middle and narrow front and rear portion (column 11, lines 3-11, Figs. 12-13). The robot 100 comprises a gantry on a track structure 40 with a two gripping jaws 105. One particular gripping block 560 may be provided on the top of a reagent package, which contains reagents used by instrument 10. Gripping block 560 has a front wall 563 and a back wall (not shown but shaped like front wall 563) which is curved to fit within the contour of fingers 105 and two curved flanges, front flange 561 and rear flange 562, which may follow the same curvature as the front and back walls. Groove 552 serves to properly align an otherwise misaligned container at the time the

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container is retrieved. If a reagent package with gripping block 560 or a similar means for gripping the container is not seated at its pick up location completely vertically when robotic arm 100 arrives to pick it up, projections 550, 551 and groove 552 help align the reagent package as fingers 105 close around gripping block 560 by catching flanges 561, 562 of gripping block 560 in groove 552. The top of the flange that is raised too high hits the bottom of projection 551 and is pushed downward while the bottom of the other flange that is too low is pushed upward by the top of lower projection 550. Groove 552 between projections 550, 551 is sized to grasp the top flanges 561, 562 on opposite sides of gripping block 560, while providing some additional space allowance for realignment of the flanges and to prevent flanges 561, 562 from getting stuck in groove (column 12, line 36- column 13, line 18). Additionally, Cohen *et al* teach in an alternative embodiment pneumatically operated power assembly (column 10, lines 33-63). Cohen *et al* do not specifically recite a pipetting nest having a spring-loaded v-shaped members for limiting the movement of the reagent pack during pipetting. Anami does teach a pipetting nest having spring-loaded v-shaped members 73, 73a for limiting the movement of the container during pipetting (column 9, lines 35-54, Fig. 2). Such a spring-loaded gripping means provides stability while the container is accessed by pipette 50 (column 10, lines 44-45). Moreover, such a pipetting nest having spring-loaded v-shaped members is considered conventional in the art as admitted by Applicants in the Amendment filed December 18, 2002 on page 6, last line of the first full paragraph.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to have included in the robotic device of Cohen the pipetting nest having

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spring-loaded v-shaped members, in order to provide stability while the container is accessed by pipette.

Response to Arguments

7. Applicant's arguments filed December 18, 2002 have been fully considered but they are not persuasive. In response to the rejection of claims 9-10, 14-15 under 35 U.S.C. 103(a) as being unpatentable over Cohen *et al* (USP 6,293,750 B1) in view of Anami (USP 5,5825,298), Applicant argues that Anami does not teach a "multiplicity" of compartments and only teaches "one" v-shaped member. Applicant maintains that the present invention as claimed requires a pipetting nest having a multiplicity of compartments each adapted for retaining one respective reagent pack, including "spring-loaded v-shaped members" located in the pipetting compartment for limiting the movement of the reagent pack during pipetting. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner contends that Cohen *et al* is relied up on for the teaching of a multiplicity of compartments for holding reagent packs and Anami does teach a pipetting nest having spring-loaded v-shaped members 73, 73a for limiting the movement of the container during pipetting (column 9, lines 35-54, Fig. 2). Moreover, the claimed pipetting compartment with spring-loaded v-shaped members not clearly shown in Figure 13 as stated by Applicant. Additionally, Applicant admits that such a pipetting nest having spring-loaded v-shaped members is considered conventional in the art, see the Amendment filed December 18, 2002 on page 6, last line of the first full paragraph.

Allowable Subject Matter

8. Claims 1-6 are allowed.

9. Claims 11-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: the instant claims are drawn to a transport and storing system which includes a multiplicity of reagent packs. The prior art fails to teach or suggest a system which includes a gantry mounted on the rack structure of the storing system such that it is movable in both the vertical and horizontal directions of a reagent pack storage nest. The storage nest having a multiplicity of compartments aligned in vertical and horizontal columns and rows. The gantry including a pair of generally oppositely disposed and synchronically movable gripping jaws and a power assembly for actuating the respective movement of the gantry, gripper mechanism and gripping jaws. The reagent packs having an elongated body such that the middle portion is wider than the front and rear portions. The reagent packs included holes with tapered conical opening on the outer sides and complementary conical pins on the inner sides of the gripping jaw of the gantry for causing the reagent pack to be slightly lifted up when engaged by the gripping jaws and moved in or out of the storage compartment. Additionally, the system includes a pipetting nest having a multiplicity of compartments aligned in at least on horizontal row, means for maintaining precise pipetting position of the reagent pack which includes spring-loaded v-shaped members located in the pipetting compartments.

Conclusion

11. Claims 1-6 are allowed. Claims 11-13 are objected to. Claims 9-10, 14-15 are rejected.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Bex whose telephone number is (703) 306-5697. The examiner can normally be reached on Mondays-Thursdays, alternate Fridays from 6:00 am to 3:30 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 308-4037.

The fax number for the organization where this application or proceeding is assigned is (703) 872-9310 for official papers prior to mailing of a Final Office Action. For after-Final Office Actions use (703) 872-9311. For unofficial or draft papers use fax number (703) 305-

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7719. Please label all faxes as official or unofficial. The above fax numbers will allow the paper to be forwarded to the examiner in a timely manner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Kathryn Bex

P. Kathryn Bex

Patent Examiner

AU 1743

February 20, 2003

Jill Warden
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